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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/863,722 | 05/23/2001 | John R. Martin | 10527US16 | 2165 |

7590 07/10/2006
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| EXAMINER |
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DIXON, THOMAS A

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| ART UNIT | PAPER NUMBER |
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3639

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,722

Applicant(s)

MARTIN ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16,17 and 20-27 is/are allowed.
- 6) ☒ Claim(s) 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 7 April 2006 has been considered.
2. The Terminal Disclaimer filed on 2/25/03 is acceptable

Priority

3. This application's claim for continuity data is inconsistent with PTO records according to the Bib Data Sheet.

it appears that 08/268,782 is a continuation, not divisional, of 07/846,707 and that 07/846,707 is a CIP of 07/538,931 filed 6/15/1990, now abandoned

Appropriate correction is required.

Response to Amendment

4. Applicant's arguments prompted a review of the specification, which finds the terms "compressed digital data of a graphics image," "compressed graphic image," "compressed... digital data representing the new song and associated pictorial graphics," "compressed digitized data of the picture," "associated graphics image displayed," "displaying a random sequence of available graphic images...of the compressed graphics data," "associated graphics image of the song being played," used and therefore, the previous rejections regarding the support are withdrawn.

Claim Rejections - 35 USC § 112 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as missing essential subject matter.

Claim 28 recites the limitation "receiving compressed digital song data, song identity data and pictoral graphics " in line 2. There is insufficient support for this limitation. The specification on pages 7 and 8 describe the loading of the data which includes "the new song title and category" and further the compression of the song data and a picture, as the song title data is not recited as compressed, the limitation must include "compressed pictoral graphics."

6. Claims 28, 29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as missing essential subject matter. Claims 28-30 recite the limitation "no selected song is playing." There is insufficient support for this limitation. The specification on page 12, line 11 refers to "when no song selection is playing...displaying a random sequence of available graphic images," and further "if, however, a song selection is being played when the block 161 is encountered, the attract mode sequencing does not occur"

7. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

Claim 32 recites the limitation "no unselected song is playing" in line 2. There is insufficient support for this limitation. The specification on page 12, line 11 refers to "when no song selection is playing...displaying a random sequence of available graphic images," and further "if, however, a song selection is being played when the block 161 is encountered, the attract mode sequencing does not occur"

Claim Rejections - 35 USC § 112 2nd Paragraph

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The claim recites the limitation "receiving compressed digital song data, song identity data and pictorial graphics " in line 2. There is insufficient support for this limitation. The specification on pages 7 and 8 describe the loading of the data which includes "the new song title and category" and further the compression of the song data and a picture, as the song title data is not recited as compressed, the limitation must include "compressed pictorial graphics."

9. Claims 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites the limitation "no selected song is playing ." There is insufficient support for this limitation. 6. Claims 28, 29, and 30 are rejected under 35

U.S.C. 112, first paragraph, as missing essential subject matter. Claims 28-30 recite the limitation "no selected song is playing." There is insufficient support for this limitation.

The specification on page 12, line 11 refers to "when no song selection is playing...displaying a random sequence of available graphic images," and further "if, however, a song selection is being played when the block 161 is encountered, the attract mode sequencing does not occur"

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10. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "no unselected song is playing" in line 2. The term "unselected" is unclear. The specification on page 12, line 11 refers to "when no song selection is playing...displaying a random sequence of available graphic images," and further "if, however, a song selection is being played when the block 161 is encountered, the attract mode sequencing does not occur"

Allowable Subject Matter

11. Claims 16-17, 20-27 are allowed.

12. The following is an examiner's statement of reasons for allowance:

As per Claim 16.

The prior art, specifically Castile ('502) in view of Cohen ('187) further in view of Verdun ('802) or Tashiro ('836) do not disclose or fairly teach:

a computer jukebox with a communication interface for receiving the compressed digital song data, the song identity data and the compressed pictorial graphics;
causing the processor, when no song is playing on the computer jukebox, to generate a user attract mode wherein the digitally-stored song associated graphic images are decompressed and shown on the display.

As per Claim 22.

The prior art, specifically Castile ('502) in view of Cohen ('187) further in view of Verdun ('802) or Tashiro ('836) do not disclose or fairly teach:

a computer jukebox with a communication interface for receiving the compressed digital song data and the song identity data;

causing the processor, when no song is playing on the computer jukebox to generate a user attract mode;

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox; and

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causing the management station processor to compress and transmit a subset of the digital song data and transmit corresponding song identity data to at least one selected computer jukebox to update the library of songs in the computer jukebox.

As per Claim 27.

The prior art, specifically Castile ('502) in view of Cohen ('187) further in view of Verdun ('802) or Tashiro ('836) do not disclose or fairly teach:

a computer jukebox with a communications interface for receiving compressed digital song data and the song identity data;

causing the processor, when no song is playing on the computer jukebox to generate a user attract mode;

a data storage for storing the compressed digital song data and song identity data for each of the songs stored;

processor and a memory, the memory including a decompression algorithm for decompressing compressed digital song data, and instructions for:

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox.

The claims that depend from the above allowed claims are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Arbiter et al (5,228,015) discloses running an attract mode until money is inserted, see column 5, lines 12-13, but does not disclose running compressed/decompressed digitally stored song associated graphics.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3639

July 06